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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,792	10/26/2006	Hiroyuki Kamiya	2006_1315A	9531

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WENDEROTH, LIND & PONACK, L.L.P.
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Washington, DC 20005-1503

EXAMINER

PANDE, SUCHIRA

ART UNIT	PAPER NUMBER
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1637

NOTIFICATION DATE	DELIVERY MODE
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06/01/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com
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Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	10/588,792	KAMIYA ET AL.
	Examiner	Art Unit
	SUCHIRA PANDE	1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 May 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 12, 13, 15, 16 and 23.
- Claim(s) withdrawn from consideration: 17-22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/TERESA E STRZELECKA/
Primary Examiner, Art Unit 1637
May 23, 2011

Continuation of 11. does NOT place the application in condition for allowance because: No claims have been amended. Applicant argues Examiner has provided no motivation to produce a population containing either only the + or the - strand. Examiner's response: Examiner has provided motivation to practice the method of Moriya in the method of Zarling et al. and is being reiterated here:

"It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to practice the method of Moriya et al. in the method of Zarling et al. The motivation to do so is provided to one of ordinary skill in the art by knowledge of art itself. One of ordinary skill in the art knows that when PCR amplified fragment is used as a source of single stranded DNA then denaturation of the fragment yields equimolar quantities of + (+ also referred as sense strand) and - (- also referred as antisense strand) strand (50% + and 50% -). Hence the resulting DNA is a mixture of the two strands.

One of ordinary skill in the art knows that shuttle phagemid vectors have architecture that allows one to express the desired (+sense strand) or (-antisense strand) strand. So 100 % of the DNA produced as single stranded DNA is the desired sense or antisense strand. The target gene of appropriate fragment size can be cloned in the multiple cloning site of the chosen appropriate phagemid vector. These phagemid clones can be used to produce single stranded circular DNA of desired sense. Moriya teaches how desired fragment can be cleaved from this single stranded DNA. In this case 100% of the single-stranded DNA fragment is homologous with a sense strand of the target DNA sequence, and contains the base(s) to be converted.

One of ordinary skill in the art also has a reasonable expectation that by practicing the method of Moriya in the method of Zarling et al. i.e. by cloning desired target in the phagemid taught by Moriya, one of ordinary skill in the art would be able to prepare desired (DNA fragment that is homologous with a sense strand of the target strand) single stranded DNA fragment. This single stranded DNA fragment obtained can be transfected into desired host cells to successfully perform targeted homologous recombination".

Applicant further argues regarding conversion efficiency of the claimed method and states that this superior efficiency is not taught or suggested by cited prior art. Examiner maintains the previous position and would like to point out that conversion efficiency depends on several factors such as cells being used for conversion, length of the fragment and other conditions used for transformation. The instant claims do not recite any particular conditions, not do they recite conversion efficiency, hence arguments regarding conversion efficiency are not commensurate with the scope of the claimed invention.

In conclusion, all the elements that are recited in instant claims are taught to one of ordinary skill in the art by prior art. Hence Examiner maintains the rejections are valid and are being maintained.